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Paper No. 13
AFD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Premier Products, Inc.

Serial No. 75/488,001

Ronald P. Kananen of Rader, Fishman & Grauer for Premier Products, Inc.

Julie A. Watson, Trademark Examining Attorney, Law Office 104 (Sidney I. Moskowitz, Managing Attorney).

Before Hanak, Hohein and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

Premier Products, Inc. (applicant) has filed an application to register the mark PREMIER for goods ultimately identified as "aluminum windows for metal buildings; and metal doors and metal door frames, namely steel doors and steel door frames for fire doors, for use in public buildings" in International Class 6.¹ The

¹ Serial no. 75/488,001 filed on May 19, 1998, claiming a date of first use and date of first use in commerce of January 1, 1990.

Examining Attorney has refused to register the mark under Section 2(d) of the Trademark Act because of the registration for the mark PREMIER for "vinyl windows and patio doors" in International Class 19.² Both applicant's and registrant's marks are depicted in a typed drawing.

After the Examining Attorney made the refusal final, this appeal followed. Both applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

After considering the arguments and papers of the applicant and the Examining Attorney, the Examining Attorney's refusal to register applicant's mark because it is confusingly similar to the mark of the cited registration under Section 2(d) is affirmed.

In cases involving the issue of likelihood of confusion, we look to the relevant factors set out in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973), to determine whether there is a likelihood of confusion. Not all of the du Pont factors are applicable in every case. In re Dixie Restaurants, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

In this case, the first factor that we consider is whether the marks are similar. It is obvious, and

² Registration No. 1,681,213, issued March 31, 1992. Section 8 and 15 affidavits have been accepted and acknowledged.

applicant admits (brief at 3), that the marks are identical inasmuch as both applicant's and registrant's marks are for the same word PREMIER depicted in a typed drawing.

Therefore, the next issue is whether the goods are related. To determine whether the goods are related, we must look to the identification of goods in the application and registration. Dixie Restaurants, 41 USPQ2d at 1534; Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Applicant's goods are "aluminum windows for metal buildings; and metal doors and metal door frames, namely steel doors and steel door frames for fire doors, for use in public buildings." Registrant's goods are "vinyl windows and patio doors." While applicant argues that the goods are not identical, du Pont speaks in terms of similar goods, not identical goods. du Pont, 177 USPQ at 567 ("The similarity or dissimilarity and nature of the goods and services as described in the application or registration"). See also In re Shell Oil Co., 992 F.2d 1204, 26 USPQ 1687 (Fed. Cir. 1992)(Distributorship services in the field of automobile parts related to service station oil and lubrication change services).

Applicant's most significant argument is that the goods are sold to different purchasers in different channels of trade. Applicant claims its goods are marketed for use by commercial or industrial contractors who engage in the construction of public, commercial and industrial buildings. Registrant's goods, according to applicant, are used by homeowners and residential contractors and, therefore, unrelated. There are several flaws to applicant's arguments.

One, the goods identified in the registration are not limited to those offered to homeowners or residential contractors, and therefore we must presume that the goods move through all normal channels of trade for such products. Applicant's submission of information from registrant's website and sales brochure does not serve to limit registrant's identification of goods, which is unrestricted. See Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers

to which the sales of goods are directed"). Similarly, registrant's goods must be considered on the basis of the goods as identified in the registration. We agree with the Examining Attorney that we must presume that registrant's vinyl windows and patio doors are marketed and sold to commercial and industrial contractors and not just to homeowners and residential contractors.

Second, there is no evidence in the record that the residential or commercial contractors who would purchase applicant's and registrant's goods would not overlap. We must assume that registrant's vinyl windows and patio doors and applicant's metal windows and doors would be sold to contractors who build both residential and commercial buildings.

Third, the Examining Attorney has made of record evidence from the "NEXIS" database showing that the sources of vinyl and aluminum windows are often the same.

Wintech manufactures advanced lines of welded and mechanical vinyl windows for replacement and new construction and aluminum windows for commercial and heavy commercial applications. Times Union, July 13, 1996, p. B12.

. . . plant will phase out Hara's high-end vinyl window to concentrate its efforts n the former Hara's primary vinyl window model, he said. Production of an aluminum window will continue for the time being. Idaho Business Review, Apr. 14, 1997, p. 3A.

Both its vinyl windows and aluminum windows are produced at its Pittsburgh plant, which employs about 850 people. Omaha World Herald, Dec. 26, 1994, p. 11sf.

Wade said he founded B&K in 1978 as an aluminum window producer and started making vinyl windows in 1989. Plastics News, Aug. 12, 1996, p. 6.

In addition, the Examining Attorney has made of record several third-party registrations that show that sources of aluminum windows and steel doors also produce vinyl windows. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source").

In addition to its arguments concerning the relatedness of the goods, applicant argues that there has been no actual confusion despite allegations of at least ten years of simultaneous use. It is unnecessary, however, to show actual confusion in establishing likelihood of confusion. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); J & J Smack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991). Moreover, an ex parte

proceeding provides no opportunity for the registrant to show instances of actual confusion. Thus, even if the statement of applicant's attorney was supported by evidence of record, it would not eliminate the likelihood of confusion.

Applicant also argues that the marks are not inherently distinctive and it attempted to submit a printout of 50 "PREMIER" marks and registration numbers in support of that argument. (Response dated May 30, 2000, p. 4). The Examining Attorney properly objected to this evidence and, since the Board does not take judicial notice of registrations, it will not be considered. In re Duofold, Inc., 184 USPQ 638, 640 (TTAB 1974). Even if the registrations were considered, they do not support the registration of applicant's identical mark in view of the cited registration.

Applicant's final argument is that "the mark at issue here, 'PREMIER,' lacks inherent distinctiveness and is widely used to describe products in many fields." Brief at 6. Since the registrant's mark is not registered under Section 2(f) and it is not on the Supplemental Register, it is presumed to be inherently distinctive. An applicant cannot attack the validity of a registration in an ex parte proceeding. Dixie Restaurants, 41 USPQ2d at 1534.

However, we construe applicant's argument as directed to the lack of strength of registrant's mark. "But, it does not stretch credibility to understand the laudatory nature of the word, so that copies of the registrations are mere surplusage to the point that has been established." (Brief at 7). To the extent that applicant is arguing that PREMIER is a weak mark, we have no evidence that in the field of doors and windows, the mark is weak. Even assuming applicant's point that "premier" is a frequently used laudatory term, even a weak mark is entitled to protection when the identical mark is used on closely related goods. In re Colonial Stores, 216 USPQ 793, 795 (TTAB 1982). Here, when the mark PREMIER is used on applicant's goods, there is a likelihood of confusion when the identical mark is used on vinyl windows and patio doors.

Decision: The refusal to register is affirmed.